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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,096	09/09/2003	Bamdad Bahar	0769-4624US5	9845

7590 04/28/2005  
MORGAN & FINNEGAN, L.L.P.  
345 Park Avenue  
New York, NY 10154

EXAMINER
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MARTIN, ANGELA J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,096

Applicant(s)

BAHAR ET AL.

Examiner

Angela J. Martin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/9/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/9/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. Claims 1, 3, 4, 6, 8, 10, and 17 are rejected under the judicially created doctrine of double patenting over claims 1, 6, 12, 13, and 22 of U. S. Patent No. 6,242,135 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a composite membrane comprising a porous polymeric sheet, having distributed in the polymer: inorganic particulate, metal, an organic polymer, or combination, and structure being partially filled with an ion-exchange resin; polymer has distributed therein precious metal, platinum, silica, titania; polymeric sheet is expanded porous PTFE; sheet has thickness of less than 38 microns.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1 and 16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,635,384 B2. This is a double patenting rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger, U.S. Pat. No. 3,497,394.

Rejection of claims 1, 3, 8 drawn to a composite membrane.

Berger teaches a composite membrane for use in an electrochemical apparatus (col. 2, lines 52-57) comprising a polymeric sheet having a porous structure with inorganic particulate and metal (col. 2, lines 46-72) distributed in the sheet and the porous structure is at least partially filled with an ion-exchange resin (col. 3, lines 26-33). It also teaches the metal is a precious metal, platinum, of group VIII in Periodic Table (col. 3, lines 3-9).

Thus, the claim is anticipated.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4-7, 9, 11, 12, 15, 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Berger, U.S. Pat. No. 3,497,394, in view of Zuckerbrod et al., U.S. Pat. No. 5,336,573.

Rejection of claims 2, 4-7, 9, 11, 12, 15, 18 drawn to a membrane.

Berger teaches a composite membrane as described above.

Zuckerbrod et al., teach a membrane which is a microporous sheet formed of polymeric films (col. 2, lines 42-60). It teaches distributed in the polymeric sheet is silica, fumed silica, titania (col. 5, lines 61-67 and col. 6, lines 1-5) and particulates of carbon (col. 6, lines 45-47).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to insert the teachings of Zuckerbrod et al., into the teachings of Berger because Berger teaches that this composite membrane can be adapted for use in fuel cells and batteries. Zuckerbrod et al., disclose that the particulate distributed within the polymer must be selected with respect to the battery environment (col. 6, lines 32-34). Additionally, if the composite membrane was employed in a fuel cell, it would be disposed between two fuel cell electrodes.

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8. Claims 10, 13, 14, 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger, U.S. Pat. No. 3,497,394, in view of Kejha et al., U.S. Pat. No. 5,521,023.

Rejection of claims 10, 13, 14, 16-23 drawn to a composite membrane.

Berger teaches a composite membrane as described above.

Kejha et al., teach a composite membrane comprising a polymeric sheet which is expanded porous PTFE (col. 3, lines 13-19). In addition, it teaches a porosity of up to about 90% (col. 3, lines 21-25). It also teaches polymeric sheet thickness of less than 50 microns (col. 3, lines 25-27). It teaches a polymeric gel (col. 2, lines 7-9). It teaches metal salts in the polymer (col. 3, lines 42-52).

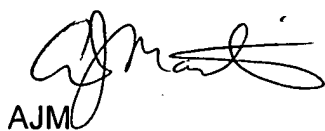
Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to insert the teachings of Kejha et al., into the teachings of Berger because Kejha et al., disclose that PTFE is inert to battery chemistry and therefore improves battery cyclability (col. 5, lines 35-37).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela J. Martin whose telephone number is 571-272-1288. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AJM